

**REMARKS**

This paper is filed in response to the Office Action dated March 18, 2004. In the March 18 Office Action, applicant's Amendment dated March 1, 2004 was found not to comply with the provisions of 37 C.F.R. § 1.111 because "[t]he reply failed to present arguments pointing out specific distinctions believed to render the claims, including any newly presented claims, patentable over the applied references." In filing a new response, it was requested that "Applicant . . . mark the claims to show the differences between the original claims and the amended claims (i.e., using brackets and underlining) and point out how these changes distinguish over the prior art."

Applicant respectfully submits that he has complied with the obligations of § 1.111 in the March 1 Amendment. In regard to independent claim 45, applicant (i) particularly pointed to limitations of claim 45 (March 1 Amendment, page 12, wherein it is stated: "In particular, it will be noted that claim 45 recites that each pay line includes one position from each of the reels and that the first group of reels includes fewer than all of the plurality of reels. Moreover, a selection of at least one pay line is received after the indicia in the positions associated with the first group of reels is displayed."); (ii) addressed the salient portions of Kojima (March 1 Amendment, page 12, first full paragraph); and (iii) stated how the limitations of claim 45 could not be found in Kojima and how Kojima actually teaches away from applicant's claimed subject matter (March 1 Amendment, paragraph bridging pages 12 and 13). Moreover, as to claims 46-54, applicant stated "that [as] Kojima does not anticipate or render obvious claim 45, claims 46-54, which depend from claim 45, are also allowable." March 1 Amendment, page 13, first full paragraph. As to claims 55-88, applicant stated that the arguments raised above relative to claim 45 apply with equal force to these claims as well. March 1 Amendment, page 13, second full paragraph.

Furthermore, applicant respectfully submits that it is not necessary, and is, in fact, contrary to the Rules, to use brackets and underlining when a new claim is being presented. 37 C.F.R. § 1.121(c)(3) states: "Any claim added by amendment must be indicated with the status of 'new' and presented in clean version, i.e., without any underlining." Therefore, applicant has not included brackets and underlining in presenting new claims 45-88.

Accordingly, applicant respectfully submits that the March 1 Amendment was fully responsive and in compliance with the provisions of 37 C.F.R. § 1.111. Consequently, the

amendments and remarks set forth in the March 1 Amendment have been reproduced in this Response for the Examiner's convenience.

### **I. Status of Amendments**

Claims 1-44 were pending prior to this amendment. By this amendment, applicant cancels claims 1-44 without prejudice to refile, and adds new claims 45-88. Thus, claims 45-88 are now pending.

Because applicant previously paid fees for 4 independent and 44 total claims, applicant's amendments do not require a further fee to be paid.

### **II. Response to Office Action**

#### **A. General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence "As used herein, the term '\_\_\_\_\_' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The October 28 Office Action**

In the October 28 Office Action, the title was objected to as allegedly non-descriptive. Applicant has deleted the old title, and presents a new title herewith. It is believed that the objection has been traversed.

Additionally, claims 1-6, 8-12, 14-20, 22-25, 30-35 and 44 were rejected under 35 U.S.C 102(b) as allegedly anticipated by Kojima (UK Published Application No. GB 2,316,214), claims 7, 26-29 and 36-43 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Kojima in view of Falciglia (U.S. Patent No. 5,971,849), and claims 13 and 21 were rejected under 35 U.S.C. 103 as allegedly unpatentable over Kojima in view of Bridgeman (U.S. Patent No. 5,046,736). As applicant has cancelled claims 1-44 without prejudice to refile, the rejections are moot. However, in light of the reliance on Kojima, applicant has the following comments.

At page 4, Kojima states:

Thus, a first payline, for example the centre row, can be generated. Next, a bet can be accepted and a pattern generated on a single additional display. The new display will form at least one new payline. Adding another display will form even more paylines so that the number of paylines added with each additional display increases as the number of bets are made.

It will be noted from the passage that Kojima states that all of the symbols along at least the first payline are displayed before the player is permitted to make a selection of a further display which will define further paylines. In fact, Kojima consistently states that all of the symbols along a first payline will be displayed before the player is given an opportunity to select a further payline in those instances where some of the symbols are displayed before a player selects all of his or her paylines. It is submitted that there is no clear disclosure, teaching or suggestion in Kojima that fewer than all of the symbols along the first payline will be displayed before the player is permitted to select other paylines.

By contrast, claim 45 recites a gaming method for an apparatus including a plurality of reels, each of the reels having a plurality of positions associated therewith in which indicia may be displayed, and a plurality of pay lines, each pay line including one position from each the reels. The method includes receiving a wager, displaying indicia in the positions associated with a first group of the plurality of reels, the first group defined as fewer than all of the plurality of reels, receiving a selection of at least one pay line after the indicia in the positions associated with the group of the plurality of reels is displayed, displaying indicia in the positions associated with a second group of reels, the second group defined as those reels not in the first group, and determining a payout according to the at least one pay line selected.

In particular, it will be noted that claim 45 recites that each pay line includes one position from each of the reels and that the first group of reels includes fewer than all of the plurality of reels. Moreover, a selection of at least one pay line is received after the indicia in the positions associated with the first group of reels is displayed. Thus, according to the claimed method, the selection of the pay line occurs before all of the indicia are displayed along any of the pay lines.

Thus, comparing with the passage cited above and the statements of Kojima taken as a whole, Kojima simply does not disclose each and every element of the claimed subject matter of claim 45. Moreover, Kojima consistently states that no selection occurs until after all of the symbols along a first payline are shown. Thus, Kojima actually teaches away from the claimed subject matter. Moreover, it is submitted that the strategies to be used by the player differ significantly when all of the symbols along a payline are displayed before the player selects a payline than when all of the paylines are incomplete.

Given that Kojima does not disclose, teach or suggest each and every limitation of the claimed subject matter, claim 45 is allowable. Moreover, given that Kojima does not anticipate or render obvious claim 45, claims 46-54, which depend from claim 45, are also allowable.

Moreover, it is applicant's position that the arguments raised above relative to claim 45 apply with equal force to claims 55, 62, and 79. That is, in keeping with the arguments advanced above, Kojima also does not anticipate or render obvious claims 55, 62, and 79. Further, given that claims 55, 62 and 79 are not anticipated or rendered obvious, claims 56-61, 63-78 and 80-88 that depend from claims 55, 62 and 79, respectively, also are allowable.

In summary, in view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. Further, if there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

Respectfully submitted for,

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